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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,995	08/31/2001	Arthur Charles Lindahl	LINDAHL-CIPI	2432
7590	12/10/2003		EXAMINER	NERBUN, PETER P
Curt Harrington Suite 250 6300 State University Drive Long Beach, CA 90815			ART UNIT	PAPER NUMBER
			3765	
DATE MAILED: 12/10/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/944,995	LINDAHL, ARTHUR CHARLES
Examiner	Art Unit	
Peter P Nerbun	3765	L

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 17 October 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-48 is/are pending in the application.  
4a) Of the above claim(s) 5,6,9,10,12,15-19,22-29,33-44 and 46-48 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4,7,8,11,13,14,20,21,30-32 and 45 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 31, lines 2-3 applicant recites a "foam piece having a porus (sic) volume and an open cell structure". The specification merely states that "cushioning strips" 557,559, and 561 may be provided (e.g. in the elected embodiment of Fig. 44). There does not appear to be any mention of a foam piece having a porous volume and an open cell structure. Similarly, in claim 32, lines 2-3, applicant recites a foam piece that has at least one surface which is impermeable. This claimed feature also does not appear to be recited in the specification. In both instances proper antecedent in the specification for the claimed subject matter is required.

Claim 31 is objected to for containing a spelling error. In claim 31, line 2, "porus" must be changed to --porous--.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,7,11,20,21,30,31, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Vinas. The patent to Vinas discloses an eyewear member 2d for use by a person wearing conventional eyewear 1d, Fig. 4, said eyewear member

comprising a substantially planar, thin walled body 102d utilizable with conventional eyewear, said body having an enclosure with at least one enlarged opening 75d, said enlarged opening to align with a lens of said eyewear, said body to provide a close fit with a face of the person using said eyewear member to diminish the entry of foreign material and light between the eyewear and the person's face, and elements 140, 142, 144 attached to said eyewear member for mounting said eyewear member in juxtaposition to the eyewear. In claim 1, lines 9-10 applicant recites "means attached to said eyewear member for mounting said eyewear member in juxtaposition to the eyewear". This is a claim limitation which invokes 35 U.S.C. 112, sixth paragraph. In accordance with MPEP 2183 a prima facie case of equivalence between the means for mounting the eyewear member in juxtaposition to the eyewear as structurally disclosed by applicant in the specification and the prior art elements 140, 142, 144 of Vinas is made as follows: Elements 140, 142, 144, Fig. 4 in Vinas perform the function specified in the claim since these elements mount the eyewear member in juxtaposition to the eyewear by adhering the eyewear member 2d directly adjacent the eyewear 1d. Elements 140, 142, 144, Fig. 4 in Vinas are not excluded by any explicit definition provided in the specification for an equivalent since the definition of the means for mounting the eyewear member in juxtaposition to the eyewear on page 52, lines 11-23 and page 53, lines 1-9 does not exclude the use of adhesive members. Finally prior art elements 140, 142, 144, Fig. 4 in Vinas are an equivalent of the means plus function limitation since the prior art element the prior art elements performs the identical function specified in the claim in substantially the same way, and produces substantially

the same results as the corresponding element disclosed in the specification. Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). In this regard note that prior art elements 140, 142, 144, Fig. 4 in Vinas perform a function of mounting the eyewear member in juxtaposition to the eyewear by holding the eyewear member 2d directly adjacent the eyewear 1d by applying forces that prevent the separation of the eyewear member 2d from the eyewear 1d. Thus the examiner concludes that the claimed limitation is met by the prior art elements. With regard to claim 11 note that element 42d is a strip since a strip is a long narrow piece of material. With regard to claim 21, note the Fig. 1 embodiment in Vinas.

Claims 1-4,7,8,11,20,21,30,31, and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Olney. Note that the subject matter of claims 1-4,7,8,11,20, 21,30,31, and 45 was first disclosed in the instant Continuation-in-Part application (i.e. the subject matter of claims 1-4,7,8,11,20, 21,30,31, and 45 was not present in the parent application SN 09/352,898). Accordingly the effective filing date for the subject matter of claims 1-4,7,8,11,20, 21,30,31, and 45 is the filing date of the instant Continuation-in-Part application (viz. August 31, 2001). The effective filing date of the Olney patent is August 14, 2001. The patent to Olney discloses an eyewear member 42, Fig. 5 for use by a person wearing conventional eyewear 10, say eyewear member comprising a substantially planar, thin walled body utilizable with conventional eyewear, said body having an enclosure with at least one enlarged opening (see the two large openings in eyewear member 42 in Fig. 5), said enlarged opening to align with a lens of said eyewear, said body to provide a close fit with a face of the person using said

eyewear member to diminish the entry of foreign material and light between the eyewear and the person's face, means 47, 47', 48, 48' attached to said eyewear member for mounting said eyewear member in juxtaposition to the eyewear. In claim 1, lines 9-10 applicant recites "means attached to said eyewear member for mounting said eyewear member in juxtaposition to the eyewear". This is a claim limitation which invokes 35 U.S.C. 112, sixth paragraph. In accordance with MPEP 2183 a *prima facie* case of equivalence between the means for mounting the eyewear member in juxtaposition to the eyewear as structurally disclosed by applicant in the specification and the prior art element 47, 47', 48, 48', Fig. 5 is made as follows: The elements 47, 47', 48, 48' perform the function specified in the claim since this element mounts the eyewear member in juxtaposition to the eyewear by affixing the eyewear member 42 directly adjacent the eyewear 10. Elements 47, 47', 48, 48' in Olney are not excluded by any explicit definition provided in the specification for an equivalent since the definition of the means for mounting the eyewear member in juxtaposition to the eyewear on page 52, lines 11-23 and page 53, lines 1-9 does not exclude the use of elements that project from the eyewear member and are received in corresponding receiving elements in the eyewear. Applicant describes "conventional" eyewear in the specification on page 1, lines 20-24 and page 2, lines 1-2. The eyewear of Olney is "conventional" meets the description of "conventional" eyewear as set forth in applicant's specification. Finally prior art elements 47, 47', 48, 48' in Olney are an equivalent of the means plus function limitation since the prior art element the prior art elements performs the identical function specified in the claim in substantially the same

way, and produces substantially the same results as the corresponding element disclosed in the specification. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). In this regard note that prior art elements 47, 47', 48, 48', Fig. 5 in Olney perform a function of mounting the eyewear member in juxtaposition to the eyewear by holding the eyewear member 42 directly adjacent the eyewear 10 by applying forces that prevent the separation of the eyewear member 2d from the eyewear 1d. Thus the examiner concludes that the claimed limitation is met by the prior art elements. With regard to claim 8, note that elements 47, 47', 48, 48' constitute at least one angled projection member mounted on the body 42 since these elements extend outward at an angle of 90 degrees with respect to said body.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olney. It would have been obvious to removably affix the sealing strip 45, Figs. 1, 2 of Olney to the body 10 since the mere fact that a given structure is integral does not preclude its consisting of various elements *Nerwin v. Erlichman*, 168 USPQ 177, 179 (PTO Bd. of Int. 1969).

Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vinas in view of Vosper. To construct the eyewear member of Vinas with the enlarged

openings 75d, Fig. 4 each including a colored lens as suggested by Vosper at 30 Fig. 1 since the wearer's eyes would be better protected from the rays of the sun.

Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinas. Col. 5, lines 8-10 of Vinas states that shielding element 42 is constructed of open-cell foam that allows passage of air, but resists the passage of solid or liquid matter. It would have been obvious to form this foam layer with a surface that is impermeable to liquid since Vinas intends to make foam element resistant to permeability by a liquid.

Claims 5,6,9,10,12,15-19,22-29,33-44, and 46-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6. Applicant states that the embodiment of Figure 44 is elected as the primary provisional election and that the embodiments of Figures 45, 46, 47, and 43 should be included. It is noted that applicant states that if the examiner agrees with "the overall election of Figures 43-47, then this election can be considered as having been made without traverse". The examiner's position is that the species disclosed in Figure 43, Figure 44, Figure 45, Figure 46, and Figure 47 are all patentably distinct from each other. Therefore applicant must restrict the election to a single one of these species. With regard to the primary provisional election of Figure 44, it is noted that claim 12 does not read upon Figure 44 since there is no nosepiece disclosed in that drawing figure. Accordingly claim 12 has been withdrawn from consideration as directed to a non-elected species. Since applicant has not presented any arguments to support a

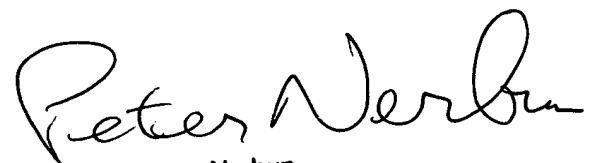
traverse of the election requirement, the election is deemed to have been made without traverse. As noted in the election requirement in paper no. 4, should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0758.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Peter Nerbun  
December 4, 2003



Peter Nerbun  
Primary Examiner